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EXAMINER

SINGH, SUNIL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,289

Applicant(s)

NORMAN ET AL.

Examiner

Sunil Singh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-26 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) 4-10, 22-24, 28, 29 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2, 3, 13-21, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Specie I in the reply filed on 1/9/06 is acknowledged.
2. Claims 22-24 and 32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Specie IV, there being no allowable generic independent or linking claim. Election was made **without** traverse in the reply filed on 1/9/06.
3. It should be noted that claims 4 and 5-10 and 28-29 are with drawn from consideration since they are directed to Species II & III and II and II respectively.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 is a duplicate of claim 16.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 31, 2-3, 13-15 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Scoville (US 2701027).

Scoville discloses an underground retention apparatus comprising in combination means (12,13 and the top half of the vertical part of members (11,18,21)) for providing perimeter structural support; means (this is considered as the bottom half of the vertical part of members (11,18,21) and the bottom of member 11) for holding a quantity of run

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off water secured to the perimeter support means; means ((16) the opening in member 15, (the opening (22) where water flows into the apparatus)) for draining run off water onto the means for holding a quantity of run off water; means for draining the run off water from the means for holding a quantity of run off water (the opening (22) where water flows away from the apparatus, see col. 2 line 16+); and means (the solid portion of member (15)) for providing a roof for covering the holding means and for providing structural support for appropriate usage of the roof means and disposed on the perimeter support means.

(Re claims 2,18), the perimeter support means (this is considered as the top half of the vertical part of members (11,18,21) and 12,13) comprises a generally vertically retaining wall (see Figs. 1,2).

(Re claim 3), the means for draining run off from the holding means includes a dry well (see col. 2 line 34).

(Re claim 13), the holding means includes an upper side wall portion (this is considered as a top portion of the bottom half of the vertical part of members (11,18,21)), a lower side wall portion (this is considered as a bottom portion of the bottom half of the vertical part of members (11,18,21)), and a bottom portion (this is considered as the bottom of member 11).

(Re claims 14,15), since applicant does not specify with respect to what reference point the term shallow angle and steep angle are measured to; it appears based on Figures 3 and 4, that Scoville discloses that the upper side wall portion is

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disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle.

(Re claim 19), the holding means is secured to the vertically disposed retaining wall.

(Re claim 20), the retaining wall is considered to be relatively short.

(Re claim 21), the retaining wall is considered to be relatively long.

8. Claims 31, 13-16 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Whitfield, Jr. (US 6419421).

Whitfield, Jr. discloses an underground retention apparatus ((11), see Fig. 7) comprising in combination means (2) for providing perimeter structural support; means (3) for holding a quantity of run off water secured to the perimeter support means; means (this is considered as the hole (shown in member 3) where water enters the retention apparatus, or the grate openings shown in Fig. 7) for draining run off water onto the means for holding runoff water; means (this is considered as the hole (shown in member 3) where water leaves the retention apparatus) for draining the run off water from the means for holding water runoff; and roof means (5) disposed on the perimeter support means for covering the holding means and for providing structural support for appropriate usage of the roof means.

(Re claim 13), the liner means includes an upper side wall portion (this is considered as a top portion of side plate (3)), a lower side wall portion (this is

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considered as a middle portion of side plate (3)), and a bottom portion (this is considered as the bottom portion of side plate (3)).

Re claims 14,15), since applicant does not specify with respect to what reference point the term shallow angle and steep angle are measured to; it appears that Whitfield Jr. discloses that the upper side wall portion is disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle.

(Re claim 16 and 30), the liner is made of plastic (see abstract).

9. Claims 31, 2, 13-15, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Jordan et al. (US 3950252).

Jordan et al. discloses an underground retention apparatus (20, see Fig. 7) comprising in combination means (see Fig. 7, (100)) for providing perimeter structural support; means (97,22, 24,27-30) for holding a quantity of runoff water secured to the perimeter support means; means (63 or holes in member (101) shown in Figure 7) for draining run off waste water onto the holding means; means for draining the filtered water from the holding means (83); and roof means (member 101 or the solid portion or member 101 depicted in Figure 7) disposed on the perimeter support means for covering the holding means and for providing structural support for appropriate usage of the roof means.

(Re claims 2, 18), the perimeter support means comprises a retaining wall.

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(Re claims 13-15), Jordan et al. discloses that the upper side wall portion is disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle (see Figs. 2 and 7).

(Re claim 17), the liner is made of cementitious material (see col. 2 line 1)

(Re claim 19), the liner means is secured to the vertically disposed retaining wall.

(Re claim 20), the retaining wall is considered to be relatively short.

(Re claim 21), the retaining wall is considered to be relatively long.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 16,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scoville 027.

Scoville discloses the invention substantially as claimed. However, Scoville is silent about the holding means being made out of either plastic or cementitious material. The examiner takes official notice that it is well known to make liner/reservoir/drainage means out of plastic or cementitious material. It would have been considered obvious to one ordinary skill in the art to modify Scoville by making his liner out of plastic or cementitious since such material are known to be used to make

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liners/reservoirs/drainage means in order to have liner/reservoir/drainage means that would not be subjected to rust. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield, Jr.. Whitfield, Jr. discloses the invention substantially as claimed. However, Whitfield, Jr. is silent about the liner being made out of cementitious material. The examiner takes official notice that it is well known to make liner/reservoir out of cementitious material. It would have been considered obvious to one ordinary skill in the art to modify Whitfield, Jr. by making his liner out of cement since such material is known to be used to make liners in order to have liner/reservoir that would not be subject to rust. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

13. Claims 11,12,25,26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments filed 1/9/06 have been fully considered but they are not persuasive.

Applicant argues that the claims must be read in light of the specification and that his water retention apparatus is usable for a shopping center where appropriate use for the roof means is for parking vehicles. The examiner agrees that the claims should be read in light of the specification; however, limitations of the specification cannot be read into the claims. For example, Scoville is a retaining apparatus constructed out of heavy duty iron (see col. 1); therefore, the tire etc. of a vehicle can rest above it.

Applicant's argument with regards to the caisson and L-beam is moot, since this is directed to a non-elected Specie.

Applicant argues that Jordan does not disclose the perimeter support element as found in the specification and in claim 31. First of all, the subject matter recited in the specification is not required by the claims and as such not needed to be met in order to anticipate the claimed subject matter. Secondly of all, it is unclear why (see Fig. 7,100) does not meet the limitation "means for providing perimeter structural support".

Applicant argues that Scoville does not have separate support means and holding means. It should be noted that such argument is far more limiting than the claimed subject matter. Where in the rejected claims do it say that the support means is separate from the holding means.

Applicant argues that it is unclear how the same retaining wall can be considered both short and long. It should be noted that applicant does not set forth what constitutes short and long. Therefore, Scoville teaches both.

Applicant argues that the top of Withfield sits on the four corner posts only at four places not along the entire perimeter of the top. It should be noted that such argument is far more limiting than the claimed subject matter. The fact that the top sits on four corner posts along the perimeter of the top then it meets the limitation of perimeter support means. The claim does not require that the perimeter support means support the top along its entire perimeter. Applicant argues that the examiner considered the side walls as both the perimeter support means and the retention means. This is incorrect. The examiner explicitly considered member (2) as the means for providing perimeter structural support and member (3) as the means for holding a quantity of runoff water secured to the perimeter support means.

Applicant argues that none of the references resembles his invention. The examiner would like to point out to applicant that in an utility application one compares the claim language with the prior art and not if the figures look alike.

In response to applicant's argument that Jordan is for a different purpose, it should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.

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Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (571) 272-7051. The examiner can normally be reached on Monday through Friday 10:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Engle Patricia can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673



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2/23/06